

Application No.: 10/523,839  
Art Unit: 1795

Amendment under 37 CFR §1.111  
Attorney Docket No.: 052077

**AMENDMENTS TO THE DRAWINGS**

The attached replacement sheet of drawings includes changes to Figs. 7-12. In the attached sheet of drawings, “PRIOR ART” references have been added.

### **REMARKS**

Claims 9-25 are pending in the application. By this Amendment, claims 9-10, 12, 16-17, 19 and 23 have been amended, claims 14-15, 21-22 and 24-25 have been cancelled and claims 26-29 have been added. It is submitted that this Amendment is fully responsive to the Office Action dated December 29, 2008.

### **Amendment**

By this Amendment, the specification has been amended to correct translation errors. Specifically, “inclined plane” or “inclined planes” has been amended to “inclined surface” or “inclined surfaces.”

Moreover, the specification has been amended to clarify the paragraph beginning **on page 11, line 10**. No new matter has been added by the present Amendment.

### **Priority Document Acknowledgment**

The Examiner has not acknowledged that a certified copy of the priority document was received from the International Bureau (PCT Rule 17.2(a)), even though the certified copy of the priority document has been entered in PAIR system. As such, it is respectfully requested that the Examiner acknowledges receipt of the priority document for the present application.

### **Specification**

On page 2, item 2 of the Action, the specification is objected to because it is requested that Applicants include “Japanese” or similar language to describe the priority document. Moreover, it is requested that the Brief Description of Figures sets forth all of the drawing figures including Figs. 1a-1c and 9a-9c.

This objection is respectfully traversed. It is submitted that such errors have been corrected by the present Amendment.

### **Drawings**

The formal drawings are objected to as Figs. 7-12 should include a designation of “Prior Art.”

This objection is respectfully traversed. It is submitted that Figs. 7-12 have been amended to include a designation of “PRIOR ART.”

### **Claim Rejections - 35 U.S.C. § 112**

**Claims 9-22 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement.**

This rejection is respectfully traversed. Specifically, the Examiner alleges that the specification requires inclined planes only near valleys (4b) among the ridges (4a) of an edge disk cutter (4) and so the independent claims are required to include this claimed subject matter.

It is submitted that all independent claims 9, 16 and 23 have been amended to include **“an inclined surface of said edge disk cutter that contacts with said ridge at least at a part of contact with said notch”** to overcome this rejection. This amendment is supported by, for example, the specification (page 9, lines 1-2). Moreover, independent claims 9, 16 and 23 have been amended to include the subject matter of “a ridge disposed at the periphery of said edge disk cutter” supported by, for example, claim 10. Accordingly, withdrawal of this rejection is respectfully requested.

**Claims 14, 15, 21 and 22 are rejected under 35 U.S.C. §112, second paragraph as including indefiniteness.**

It is submitted that claims 14, 15, 21 and 22 have been canceled by the present Amendment. Accordingly, this rejection is now moot.

**Claim Rejections - 35 U.S.C. §102**

**Claims 9-13 and 16-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Tanaka et al. (USP 5,136,765).**

This rejection is traversed. The Examiner alleges that “this disk cutter comprises the claimed notch 3 provided at the periphery of the edge disk cutter, which notch penetrates the

edge disk cutter in the thickness direction of the disk cutter.” However, in Tanaka, the notch 3 does **NOT** penetrate the edge disk cutter in the thickness direction of the disk cutter.

The notch (relief) 3 of Tanaka is a rectangular portion indicated by the reference numeral 3 in Fig. 1. As clearly shown in Figs. 3 and 4, the rectangular portion 3 does **NOT** penetrate the edge disk cutter in the thickness direction of the disk cutter.

Accordingly, Tanaka fails to disclose or fairly suggest the claimed feature of “*a notch provided at the periphery of said edge disk cutter and **penetrating** said edge disk cutter in the thickness direction of said edge disk cutter,*” as called for in independent claims 9, 16 and 23.

The Examiner might find that it is a valley between two projections 2, not the notch (relief) 3, which penetrates the edge disk cutter in the thickness direction of the disk cutter. However, all independent claims 9, 16 and 23 have been amended to include “*wherein said notch is formed at an edge node forming part.*” This amendment is supported by, for example, the specification (page 11, lines 17-21). It is submitted that the valley between the two projections 2 (except the relief 3) is **NOT** the “*edge node forming part.*” In other words, in Tanaka, the relief 3 is the “*edge node forming part.*”

Therefore, Tanaka is silent regarding the notch that meets both claimed features “penetrating the edge disk cutter in the thickness direction of the edge disk cutter” and “formed at an edge node forming part.”

Accordingly, independent claims 9, 16 and 23 distinguish over Tanaka. Claims 10-13, 17-20 and 26-29 are dependent from claim 9, 16 or 23 and recite the additional features set forth

therein. Accordingly claims 10-13, 17-20 and 26-29 also distinguish over Tanaka for at least the reasons set forth above.

### **Request for Rejoinder**

On page 2 of the Office Action dated September 10, 2008, restriction was required between Group I, Claims 9-22 and Group II, Claims 23-25. The Examiner alleged the reasons for lacking the same or corresponding special technical features between Groups I and II:

Group I comprises a ridge that protrudes by 30% or greater of the thickness of a sheet from a reference plane of the disk cutter cluster, which special technical feature is not part of Group II.”

By this Amendment, the claims have been amended such that Group II comprises a ridge that protrudes by 30% or greater of the thickness of a sheet from a reference plane of the disk cutter cluster. Therefore, Applicants believe that Groups I and II relate to a single general inventive concept under PCT Rule 13.1. Accordingly, it is respectfully requested that the Examiner **REJOINS** non-elected Group II.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

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If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,  
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Enclosures: Petition for Extension of Time  
Replacement Sheets of Drawing (Figs. 7-12)  
Limited Recognition